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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,930	02/27/2004	David Martyn Roessler	GP-302457	9546

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EXAMINER

LEE, GUNYOUNG T

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/788,930	Applicant(s) ROESSLER, DAVID MARTYN	
	Examiner Gunyoung T. Lee	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01/23/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 01/23/2006.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on January 23, 2006 has been entered:
 - Claims 11 and 14-15 have been amended;
 - Claims 1-10 and 18-20 have been cancelled;
 - Claims 11-17 are still pending in this application, with claim 11 being independent.

Response to Arguments

2. Applicant's arguments regarding newly amended claims 11-17 filed on January 23, 2006 have been fully considered, but they are not persuasive.
3. In response to applicant's argument regarding newly amended claims 11-17 that "there is no disclosure or suggestion of **applying** the article or molding to a vehicle roof assembly" (Remarks, pages 4-5), the phrase "**vehicle roof**" is recited in the **preamble** of claim 11. It is clearly addressed in the MPEP that a preamble is not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure (see MPEP § 2111). Further, it is implicitly disclosed in Benavides (US 5,053,930) cited in the Office Action dated on October 18, 2005 that the phosphorescent illuminating device of Benavides is used on a vehicle roof (sunroof), as described below.

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4. In response to applicant's argument regarding newly amended claims 11-17 that "Benavides (*prior art*) does not teach or suggest a roof assembly" (Remarks, pages 5-7), it is clearly addressed in the MPEP that the motivation for **modifying** the teachings of the prior art to produce the claimed invention does not need to come from the reference itself (see MPEP § 2143 - § 2143.03). Benavides discloses that the phosphorescent illuminating device is used as a vehicle interior item (col. 6, lines 59-61) placed on/near a light conducting part of the vehicle, such as a sunroof or rear and side windows (col. 4, lines 38-45). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the phosphorescent illuminating device of Benavides on/near the sunroof of a vehicle, for the purpose of increasing the safety of the driver by providing easily locatable switches (e.g. sunroof control switches) in darkness, as well as providing pleasure to the driver and passenger (especially children) with various shapes of glowing parts placed near/on the sunroof wall.

5. In response to applicant's argument regarding newly amended claims 11-17 that "the present claims are directed to a self illuminating roof assembly that illuminates interior of a vehicle, not merely a system to enhance visibility of an accessory" (Remarks, page 6), Benavides clearly discloses that the phosphorescent illuminating device (could be an accessory) enhances the visibility by self illuminating (glowing) (abstract, lines 1-5). Therefore, the self-illuminating (glowing) accessory is inherently illuminating the interior of a vehicle while it is glowing. Further, it has been held that "apparatus claims cover **what** a device **is**, **not what** a device **does**." *Hewlett-Packard*

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Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Claim Objections

6. Claim 14 is objected to because of the following informalities: (a) there are **more than one** transitional phrases "comprises" and "comprising" in line 2 (see MPEP § 2111.03); and (b) the phrase "the foregoing phosphors" in line 3 renders the claim indefinite, because it is not clearly whether the phrase refers to all three groups "non-oxide phosphor, oxide phosphor or combination of both" or one of them. Appropriate correction is required.

7. Claim 15 is objected to because of the following informality: the phrase "the zinc sulfide doped with a transition being configured to provide a glow light discharge with a particular hue" in lines 3-4 of claim 15 is not a proper format a member of Markush Group (see MPEP § 2173.05). Appropriate correction is required.

Claim Rejections - 35 USC § 103

(Regarding claims 14-15, as best understood)

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The claims must be given their broadest reasonable interpretation. See MPEP § 2111.

10. Claims 11-12 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benavides (US 5,053,930) in view of Britt et al. (US 4,401,050).

11. Benavides was a phosphorescent illuminating device for a vehicle interior (col. 6, lines 50-61).

12. In regards to claims 11-17, Benavides discloses;

- An interior panel having a phosphorescent material and a polymer matrix (col. 6, lines 50-51) (claim 11);
- Wherein the phosphorescent material is dispersed within the polymer matrix (col. 6, lines 50-51) (claim 12);
- A light-conducting component (Fig. 1, 30, 38) disposed between a location external to the vehicle (20) and a point adjacent to the interior panel to transmit external light to the interior panel (col. 4, lines 38-41) (claim 16);
- Wherein the light-conducting component (Fig. 1, 30, 28) includes an existing window of the vehicle (20) (claim 17).

13. However, Benavides does **not** expressly **but** implicitly discloses:

- A roof wall having an exterior surface (claim 11).

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Benavides discloses that the top of a vehicle (Fig. 1, 20) is constructed with a roof wall (sunroof) obviously having an exterior surface and an interior surface and conducting light into the vehicle. Benavides further discloses that the phosphorescent illuminating device is placed on/near a light conducting part of the vehicle, such as a sunroof or rear and side windows (col. 4, lines 38-45). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the phosphorescent illuminating device of Benavides on the roof wall (sunroof), for the purpose of increasing the safety of the driver by providing easily locatable switches (e.g. sunroof control switches) in darkness, as well as providing pleasure to the driver and passenger (especially children) with various shapes of glowing parts placed near/on the sunroof wall.

14. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benavides (US 5,053,930) as applied to claim 11 above, and further in view of Britt et al. (US 4,401,050).

15. In regards to claims 13-15, Benavides discloses the invention substantially as claimed except for:

- Wherein the phosphorescent material is disposed on at least one surface of the polymer matrix (claim 13);
- Wherein the phosphorescent material being configured to form a pattern on or in the polymer matrix (claim 14);

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- Wherein the phosphorescent material includes a non-oxide phosphor, an oxide phosphor, or a combination of both (claim 14);
- Wherein the non-oxide phosphor is selected from a group consisting of zinc sulfide, zinc sulfide doped with a transition metal, and zinc sulfide doped with a rare earth metal (claim 15).

16. In regards to a phosphorescent material disposed on at least one surface of the polymer matrix (claim 13) with a pattern (claim 14), Britt et al. disclose a phosphorescent lighting device (Fig. 2) having a phosphorescent material (16) disposed on at least one surface (22) of the polymer matrix (12) with a pattern (Fig. 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the phosphorescent material as shown in Britt et al. for the phosphorescent illuminating device of Benavides, for the purpose of providing a protection on the phosphorescent material by placing under the polymer layer, and enhancing the pleasure to the passenger by providing self-illuminating parts in various shapes.

17. In regards to the phosphorescent material as one of a non-oxide phosphor, an oxide phosphor, or a combination of both (claim 14), wherein the non-oxide phosphor is one of zinc sulfide, zinc sulfide doped with a transition metal, and zinc sulfide doped with an earth metal (claim 15). It would have been obvious to one of ordinary skill in the art at the time of the invention to choose the phosphorescent material within a non-

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oxide phosphor, an oxide phosphor, or a combination of both, since it is well known and generally available to one of ordinary skill in the art as phosphorescent materials.

Further, it has been held to be within the general skill of a worker in the art to select a known material on the basis of the suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Conclusion

18. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gunyoung T. Lee whose telephone number is (571) 272-8588. The examiner can normally be reached between 7:30 - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea can be reached at (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GTL

3/22/2006



JOHN ANTHONY WARD
PRIMARY EXAMINER